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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/013,541      | 01/26/1998  | JOHAN P.M.G. LINNARTZ | PHN16210            | 3468             |

7590 03/06/2003

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| EXAMINER |
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MEISLAHN, DOUGLAS J

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| ART UNIT | PAPER NUMBER |
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2132

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/013,541

Applicant(s)

LINNARTZ, JOHAN P.M.G.

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the supplemental amendment filed 18 December 2002 that added claims 20 and 21 while amending claims 1, 5, 9, and 11. An amendment had been filed 23 October 2002, which had amended claims 1, 5, 6, 11, and 18. These amendments are not apparent in the supplemental response (see, for example, claim 6), and so the comments in the October communication are not treated.

### ***Response to Arguments***

2. Applicant's arguments filed 18 December 2002 have been fully considered but they are not persuasive.

3. Applicant argues that Oshima et al. shows the reading of a mark's position rather than the reading of the mark. Generally, reading a characteristic of an element reads on reading the characteristic. More specifically, Oshima et al.'s mark is just a position. It is not required to contain other information. As such, reading the position information of Oshima et al.'s mark is the only way to read the mark.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reading the contents of a medium mark) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicant has added a player that checks the relationship between the medium mark and a digital signature, proclaiming that the previous action had not addressed this feature. While use of the data on the disk and the associated protection measures is obvious without further explanation, figure 18 in Oshima et al., which was cited in the previous office action, actually details the process of checking the medium mark against the digital signature and enabling use of data on the disk if the comparison is OK. The process mandates means for performing the steps.

6. Applicant's third criticism of the rejection based on Oshima et al. and Moskowitz is refuted because the medium mark of the claims does not necessarily contain any information. See paragraph 4 above.

7. Applicant contends that Moskowitz does not show embedding a watermark representing a second bitpattern related to the first bitpattern "in" user information. Instead, applicant says that Moskowitz teaches "a digital signature . . . embedded in a watermark not as a watermark to check the validity of the watermark." It is unclear if applicant means that the digital signature is not meant to check the validity of the watermark or if its purpose is to check the validity of the watermark. It is clear that applicant believes that the digital signature is not a watermark. However, applicant also admits that the watermark is part of a watermark, which does not coincide with the assertion that the digital signature is not a watermark.

As part of Moskowitz's watermark, the digital signature in Moskowitz would, in and of itself, read on applicant's watermark. In addition, Oshima et al. do not provide other information other than the digital signature (main ciphertext) that could be used as

a watermark. As such, the teaching of Moskowitz is to implement Oshima et al.'s digital signature as a watermark.

8. Applicant's comments with respect to claims 5, 9, 11 are similar in content to those presented with respect to claim one, and they are unpersuasive for similar reasons. The patentability of all dependent claims is based on, and unpersuasive for the same reasons as, the alleged patentability of the independent claims.

1.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima et al. (5761301) in view of Moskowitz et al.

In their abstract, Oshima et al. disclose a medium mark on an optical disk. See part 819b of figure 1 for reading a medium mark from the record carrier. The position information is sent to an encryptor that creates a digital signature of the position information, as described in the abstract. The digital signature reads on applicant's second bitpattern, while the position information reads on applicant's first bitpattern. Figure 18 shows the entire process of forming the digital signature and then verifying it.

Oshima et al. do not say that the digital signature is embedded as a watermark in user information. In lines 44-57 of column 6, Moskowitz presents the beneficial method

of embedding digital signatures as watermarks in content. Content is user information in that it is used by the user. This embedding provides nonrepudiation and validation. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to embed the signatures described in Oshima et al. as watermarks into the user information in order to assure nonrepudiation and validity.

Figure 18 of Oshima et al. anticipates the limitations specific to claims 2 and 3. Claim 4 is obvious because signing keys are (supposed to be) unique to devices and the software maker is disclosed as including both the embedding apparatus and the signature generator. Claim 5 contains limitations already discussed in claim 1. Element 819a of Oshima et al.'s first figure meets the first clause of claim 6. Data used to interpret the mark into the first bitpattern reads on applicant's seed and thus the second clause of claim 6 and claim 7.

Moskowitz and Oshima et al. have both taught the benefit of creating digital signatures as a way to secure information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a cryptographic one-way function to create the first bitpattern, thereby meeting the limitations of claim 8.

The output disc of Oshima et al., when modified by the teachings of Moskowitz, contains the elements of claim 9. Claim 10 is obvious in view of Moskowitz's teaching of a digital signature being used to verify data. As such, it would be obvious to identify the content being watermarked. Claim 11 is covered by the above discussion of claim 1 and figure 18 in Oshima et al. Figure 18 also foresees claim 12. Claim 13 is covered

by Moskowitz's discussion of secure hash functions. The limitations of claim 14 are rendered obvious by Moskowitz's discussion of digital signatures.

With respect to claim 15, the recorder has already been shown to means for reading the first bit pattern from the record carrier. The presence of this bitpattern in itself indicates a copy protection status, that being that the content is copy protected. The rest of the elements of claim 15 have been discussed above. The content of claims 16 and 17 has already been discussed. The "OK?" with two exiting paths in figure 18 of Oshima et al. anticipates a switch and thus claims 20 and 21.

4. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima et al. and Moskowitz as applied to claim 1 above, and further in view of Naccache et al.

Oshima et al. and Moskowitz show an information carrier that contains watermarked information, wherein the watermark is derived from a physical characteristic of the information carrier. They do not say that the physical characteristic is implanted during manufacture in a fashion different from writing the watermarked information to the carrier. Naccache et al. show an information carrier that derives a signature from a physical characteristic of the carrier. This characteristic is embedded during manufacture in a manner different from writing the standard information to the carrier. This indelibly associates the characteristic to the data carrier. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to indelibly press the physical characteristic necessary in Oshima et al. as described by Naccache et al.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.



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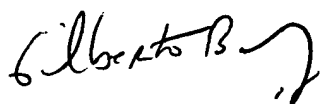
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



DJM

March 4, 2003

Douglas J. Meislahn  
Examiner  
Art Unit 2132



GILBERTO BARRON  
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